

## **REMARKS**

The issues outstanding in the Office Action mailed July 1, 2008 are the rejections under 35 U.S.C §§112, 103 and the doctrine of double patenting. Reconsideration of these issues, in view of the following discussion, is respectfully requested.

### **Rejection Under 35 U.S.C §112**

Claim 2 has been rejected under 35 U.S.C §112, second paragraph. The species recited in claim 2 which are excluded by the proviso in claim 1 have been cancelled for clarity.

Withdrawal of the rejections is therefore respectfully requested.

### **Rejections Under 35 U.S.C §103**

Claims 1, 3 - 4, 8 - 9 and 11 have been rejected under 35 U.S.C §103 over Andou ('740 or '223). Reconsideration of this rejection is respectfully requested. At pages 2 - 4 of the Office Action, it is argued that the reference formula "reads on" presently claimed Formula IA and/or is "encompassed by" the referenced formula. At page 4 of the Office Action, it is argued that the reference differs from the present invention in that the present invention is "not exemplified." It is respectfully submitted that the rejection fails to establish reasons why it would be obvious to select the presently claimed formula from the "encompassing" disclosure of the reference. Without such discussion, it is clear that a case of prima facie obviousness has not been made, and withdrawal of the rejection is therefore respectfully requested.

Claims 1 - 9 and 11 have been rejected under 35 U.S.C §103 over Heckmeier ('776). Claims 1 - 9 and 11 have also been rejected under 35 U.S.C §103 over Heckmeier ('384 of '365). Reconsideration of these rejections is respectfully requested. It is respectfully submitted that none of the listed Heckmeier references constitute prior art under 35 U.S.C §103,

#### *Statement of Common Ownership*

The present application, Serial No. 10/568,997, and U.S. Application Nos. 2004/173,776, 2003/234,384 and 2005/040,365 were, at the time the present invention was made, commonly owned by Merck Patent GmbH.

Withdrawal of the rejections over these references is thus respectfully requested.

### **Double Patenting**

Claims 1 - 9 and 11 have been rejected under the doctrine of obviousness-type double patenting over the claims 1 - 12 of U.S. Patent No. 7,175,891; claims 1 - 21 of U.S. Patent No. 7,105,210 and claims 1 - 12 of U.S. Patent No. 7,056,561. Reconsideration of each of these rejections is respectfully requested. It appears to be argued at page 7 of the Office Action that the present claims encompass the claims of the cited patents and/or there is overlap. However, mere overlap is insufficient to establish a case of prima facie obviousness, which is necessary for "obviousness-type" double patenting. Reconsideration of these rejections is thus respectfully requested.

The claims of the application are submitted to be in condition for allowance. However, if the Examiner has any questions or comments, he is cordially invited to telephone the undersigned at the number below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Harry B. Shubin/

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